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Docket No.: E-41422

DEC 04 2006

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MAIL STOP: APPEAL BRIEF-PATENTS

By: 

Date: March 24, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

Applic. No. : 10/014,265 Confirmation No.:2778

Inventor : Rolf Brück, et al.

Filed : November 7, 2001

Title : Combustion Engine Assembly with a Small Volume Catalytic Converter

TC/A.U. : 1764

Examiner : Alexa Doroshenk Neckel

Customer No. : 24131

Hon. Commissioner for Patents  
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

In response to the Examiner's Answer dated October 2, 2006,  
kindly consider the following remarks:

Application No. 10/014,265  
Reply Brief, dated 12/4/06

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Remarks:

On page 6 of the Examiner's answer, the Examiner alleges that "appellant argues that none of the references, individually, disclose having an effectiveness of more than 98%".

As will be seen from the following remarks, the Examiner's allegation is not accurate. Appellants' arguments are directed to the combination of the references and not toward the references individually. The arguments in the appeal brief deal with the combination of the references and do not attack the references individually. Accordingly, the Examiner's allegations that appellants' arguments attack the references individually, are not accurate. Therefore, the honorable Board is kindly requested to disregard the Examiner's comments.

On page 7 of the Examiner's answer, the Examiner alleges that "it is the examiner's position that the combination of Abe et al., Machida et al. and Chalasani et al. result in a device with all of the same structural properties as those recited in the claims; therefore such a device would inherently possess the same effective properties as the claimed device."

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As will be seen from the following remarks, the Examiner's allegations are not correct.

MPEP § 2112 (8th edition, 1st revision) states that:

**EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

As discussed in MPEP § 2112, a limitation recited in a claim that is not expressly or implicitly disclosed in a prior art reference is inherently disclosed therein if, and only if, the "missing" limitation is **necessarily present** in the prior art, and that it would be so **recognized by persons of ordinary skill**. The principles of inherency require that the inherency be absolute, and not **probabilistic**. As far as Applicants were able to ascertain, there is no disclosure or

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suggestion that with a combination of Abe et al., Machida et al. and Chalasani et al., it is **absolutely necessary** that the effectiveness be greater than 98%.

Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that a combination of Abe et al., Machida et al. and Chalasani et al. necessarily discloses or suggest purposefully the effectiveness be greater than 98%. Instead of offering factual evidence disclosing or suggesting an effectiveness of more than 98%, the Examiner made a statement without any factual support or Official Notice. The Examiner cannot simply be the devil's advocate postulating certain results or processes that may or may not occur or be present in the applied prior art and leave it up to Applicant(s) to show or prove the contrary. Accordingly, the Examiner has not shown that a combination of Abe et al., Machida et al. and Chalasani et al. necessarily discloses or purposefully suggests the effectiveness be greater than 98%. Therefore, the honorable Board is kindly requested to disregard the Examiner's comments pertaining to the combination of Abe et al., Machida et al. and Chalasani et al inherently having effectiveness be greater than 98%.

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Based on the above-given remarks, the honorable Board is respectfully urged to reverse the final rejection of the Primary Examiner.

Respectfully submitted,



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